

The opinion in support of the decision being
entered today is not binding precedent of the Board.

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Paper No. ~~44~~ 13

Filed
November 20, 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

JEFFREY M. SULLIVAN,
and DANIEL ANTHONY GATELY

Junior Party,
(U.S. Patents 6,015,916 and 6,455,719),
v.

CARSTEN BINGEL,
BERTHOLD SCHIEMENZ, and MARKUS GORES

Senior Party,
(Application 09/508,057).

Patent Interference No. 104,818 (MPT)

FAXED

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

NOTICE REDECLARING AND TRANSFERRING INTERFERENCE

This interference is being redeclared to add Sullivan's newly disclosed Sullivan, U.S.
Patent 6,455,719 ("Sullivan '719"), which contains claims that are related to those of Sullivan's

involved U.S. Patent No. 6,015,916 ("Sullivan '916").^{1,2} Papers filed in this interference should include the new caption provided above. Additionally, Administrative Patent Judge Michael P. Tierney has been designated to handle the redeclared interference. 37 CFR § 1.610(a).

I. Background Information

This interference was originally declared on May 28, 2002 between Sullivan's '916 patent and Bingel, U.S. Application No. 09/508,057 ("Bingel '057"). Count 1, the sole count in interference, was a method according to Sullivan '916 claim 10 or Bingel '057 claim 8. (Notice Declaring Interference, Paper No. 1, p. 5).

As set forth in the Order Setting Times (Paper No. 19), Sullivan (Mr. Irons) indicated that he would file two motions. A motion that Bingel's claims were unpatentable under §135(b) and a motion for no interference-in-fact. The APJ entered into an expedited schedule and ordered Sullivan to file the two motions on or before September 25, 2002. (Paper No. 19, p. 3).

In Sullivan's request to modify the August 16, 2002 Order, Mr. Irons states that he did not indicate that he wished to file the two identified motions. (Paper No. 20). In the Order

¹Sullivan disclosed the existence of the '719 patent in a letter dated November 12, 2002. (Paper No. 42)

²Sullivan's '719 patent was terminally disclaimed over the earlier Sullivan '916 patent. As explained in Sullivan's Response to Action Mailed March 15, 2002:

The action mailed March 15, 2002 rejected claim 4 under the "judicially created doctrine of double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,015,916." (page 3). An executed Terminal Disclaimer is concurrently submitted.

(Sullivan '719 prosecution history, Paper No. 9, p. 1).

Vacating Orders and Setting Times (Paper No. 24), the APJ noted that Sullivan did not wish to file a motion for no interference-in-fact (Paper No. 20, p. 4, ¶8). As Sullivan no longer desired to file the motion for no interference-in-fact, the APJ vacated the expedite schedule and entered new times with a Time Period 1 of November 18, 2002 for filing preliminary motions and preliminary statements. (Paper No. 24, pages 3, 4 and 9).

In a conference call held on October 3, 2002, Sullivan (Mr. Irons) requested that the Board allow Sullivan the opportunity to submit: 1) a motion under Rule 633(a) alleging that some or all of Bingel's claims are unpatentable under 35 U.S.C. §135(b); and 2) a motion under Rule 633(b) for a judgment on the ground that there is no interference-in-fact. (Order, Paper No. 28). The APJ granted Sullivan's request but noted that "[d]ue to conflicting statements made by Sullivan, the record reflects a great deal of confusion as to whether or not Sullivan will be filing the two identified motions." (Paper No. 28, p. 2).

Bingel requested a conference call for October 31, 2002. A purported purpose of the call was to discuss the filing of a Bingel motion alleging that Sullivan's claims 10-14 were indefinite for failing to define several required substituents. (See, Sullivan Exhibit 2001). The originally scheduled call was rescheduled and held on November 5, 2002.³

Prior to the conference call, Sullivan belatedly informed the Board of the existence of Sullivan Reissue Application No. 09/651,054 ("Sullivan '054"). (Sullivan's Notice, Paper No. 29). The existence of the reissue application was determined to be relevant and material to the interference proceeding as a reissue applicant, unlike a patentee, can be required to add, amend

³The reasons for rescheduling the October 31, 2002 conference call are set forth in the November 7, 2002 Order. (Paper No. 35, pages 7-8).

and/or copy a claim. 37 C.F.R. §1.633(c)(3) and (5). (November 7, 2002 Order, Paper No. 35, p. 9). After the conference call, Sullivan expressly abandoned the '054 reissue application. (Sullivan '054 Reissue Application, Paper No. 37).

During the November 5, 2002 conference call the APJ noted that Count 1 was directed to a method according to either Sullivan claim 10 or Bingel claim 8. The APJ also noted that both Sullivan claim 10 and Bingel claim 8 failed to literally define substituents R, R¹, R² and M. For the purposes of count construction only, the APJ entered a specific construction for the R, R¹, R² and M substituents recited in Count 1. The APJ, however, requested that Bingel file an "expedited" amendment to Bingel claim 8.⁴ (November 7, 2002 Order, Paper No. 35, p. 6). Bingel has filed the expedited amendment. (Bingel Misc. Motion 2, Paper No. 40).

II. Decision on Bingel Misc. Motion 2: Entry of Bingel Amended Claim 8

Bingel has complied with the APJ's November 7, 2002 Order and has filed an amendment to Bingel claim 8. (Paper No. 40). Sullivan opposes the entry of the amendment. (Sullivan's Opposition to Bingel's Misc. Mot. 2). For the reasons provided below, Bingel Miscellaneous Motion 2 is *granted* and Bingel's amendment to claim 8 will be entered into Bingel's involved 09/508,057 application.

Sullivan's opposition alleges that the APJ is precluded from entering the amendment to Bingel claim 8 before consideration of Sullivan's proposed preliminary motion for judgment

⁴Prior to the conference call, Sullivan filed an amendment in Sullivan's reissue application, now abandoned. Sullivan reissue claim 10, which was identical to Sullivan's '916 claim 10, was amended to provide a specific definition of the R, R¹ and R² substituents. (Sullivan Opposition to Bingel's Misc. Mot. 1, Paper No. 33, Sullivan Exhibit 2003).

under 35 U.S.C. §135(b). Under Sullivan's proposal, the Board would first need to consider whether Bingel's *unamended* claim 8 is patentable under 35 U.S.C. §135(b) prior to entering an amendment that may render such a rejection moot. Sullivan fails to explain the basis for such an inefficient process.

Sullivan alleges that the request and entry of the Bingel amendment is improvident due to 35 U.S.C. §135(b) and 37 C.F.R. §1.56. Sullivan's allegations fail to identify a *prima facie* basis for unpatentability under either 35 U.S.C. §135(b) or 37 C.F.R. §1.56. Indeed, the entry of the Bingel amendment may obviate Sullivan's 35 U.S.C. §135(b) motion. Specifically, none of Sullivan's claims appear limited to the specific process of Bingel claim 8 with the R and R² substituents being methyl and butyl respectively.⁵ While the process and substituents recited in Bingel's amended claim 8 may or may not be obvious given Sullivan's patented claims, Sullivan has failed to demonstrate that they are the "same or substantially the same subject matter" as that of Sullivan. *In re Berger*, 61 U.S.P.Q.2d 1523 (Fed. Cir. 2002).

Sullivan's opposition failed to specifically explain how Bingel's amended claim 8 is the "same or substantially the same subject matter" as claimed in Sullivan's '916 patent. While the basis for Sullivan's motion under 35 U.S.C. §135(b) for Bingel's amended claim 8 is not clear, Sullivan will be allowed to file such a motion at the conclusion of Time Period 1.

Additionally, Sullivan attempts to argue that Bingel's Misc. Motion 2 violates §26(a) of the Standing Order, which requires a miscellaneous motion to state why it is timely. Bingel's

⁵For example, Sullivan '916 independent claim 1, and the claims that depend from it, require the formation of a compound of formula III that is not recited in Bingel claim 8. Sullivan's other independent claim, claim 10, and the claims that depend from it, do not recite any specific limitation for the R and R² substituents.

miscellaneous motion was filed at the request of the APJ and was filed within the time set by the APJ. 37 C.F.R. §1.636(d).

III. Redeclaration of the Interference

The interference is redeclared to add Sullivan's recently disclosed Sullivan, U.S. Patent No. 6,455,719, which issued from U.S. Application No. 09/761,151, filed January 17, 2001. Sullivan '719 is accorded a priority benefit date of January 17, 2001.

As noted in the November 7, 2002 Order, Count 1, the sole count in interference, is directed to a method according to Sullivan claim 10 or a method according to Bingel claim 8. Sullivan claim 10 requires the presence of compounds identified as Formula I and II, which refer to substituents R, R¹, R² and M. Sullivan claim 10, however, does not literally define these substituents. To clarify the construction of the count the APJ entered a count construction. That portion of Count 1 that referred to Sullivan claim 10, was construed in light of Sullivan's amendment to claim 10 filed in the, then pending, Sullivan reissue application. (November 7, 2002 Order, Paper No. 35, p. 6). Subsequent to the November 7, 2002 Order, Sullivan has abandoned the reissue application.

A. The Count and Claim Correspondence

Count 1 is replaced by new Count 2 to better define the interfering subject matter. Count 2 is as follows:

A method according to claim 8 of Bingel, U.S. Application No. 09/508,057.

The claims of the parties that correspond to Count 2 are:

Bingel, U.S. Application No. 09/508,057:	2 and 4-12
Sullivan, U.S. Patent No. 6,015,916:	1-18
Sullivan, U.S. Patent No. 6,455,719:	1

The claims of the parties that correspond to Count 2 are

Bingel, U.S. Application No. 09/508,057:	2 and 4-12
Sullivan, U.S. Patent No. 6,015,916:	1-18 ⁶
Sullivan, U.S. Patent No. 6,455,719:	1

The claims of the parties that do not correspond to Count 2 are:

Bingel, U.S. Application No. 09/508,057:	None
Sullivan, U.S. Patent No. 6,015,916:	None
Sullivan, U.S. Patent No. 6,455,719:	None

⁶As to the claimed constrained geometry metallocene complex of formula III, the APJ notes that Sullivan '916 specifically states that:

As the cited references show, the Formula II compound may be reacted with a diene, typically 1,3-pentadiene, to produce a constrained geometry metallocene complex useful as an olefin polymerization catalyst.

(Sullivan '916, col. 1, lines 60-64; see also, Devore et al. U.S. Patent No. 5,470,993, which is mentioned in Sullivan '916's background of the invention and was cited as a reference during the prosecution of Sullivan '916).

B. Revised Lists of Intended Motions

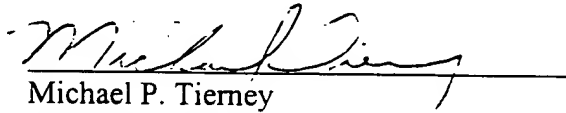
To provide the parties an opportunity to evaluate the redeclared interference and its affect on the preliminary motions phase of the interference, the APJ invites the parties to file revised lists of intended motions by no later than 5:00 p.m. on **November 25, 2002**. The lists may be filed by facsimile. The lists shall specifically plead the relief requested. Additionally, due to the redeclaration, Time Period 1 is reset for **December 10, 2002**.

IV. Order

It is:

Ordered that Bingel Miscellaneous Motion 2 (Paper No. 40) is **granted**.

Further Ordered that Bingel's amendment to Bingel claim 8, attached to Paper No. 40, be entered into Bingel, U.S. Application No. 09/508,057.


Michael P. Tierney
Administrative Patent Judge

Enclosure: (via first claim mail only)
Copy of Sullivan, U.S. Patent No. 6,455,719

cc: (via facsimile and first class mail):

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